

Remarks/Arguments

This paper addresses the issues raised in the Office Action made Final mailed 5 September 2006. This amendment is submitted in compliance with the guidelines of the revised amendment practice. See 1267 Off. Gazette 106.

Claims 32-37 and 40-50 are currently pending. Claims 32, 34, 43, 44, 46 and 48-50 were rejected under 35 U.S.C. § 102(b) as being anticipated by Perali et al (USPN 4,914,762). Claim 50 was rejected under 35 U.S.C. § 103(a) as being unpatentable over Perali. Claims 48 and 49 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perali et al in view of Marrone (USPN 5,007,449). Claims 33 and 35 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to Claims 32 and 34, and further in view of Gewecke (sic) (USPN 3,368,560). Claims 36-41 were rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to Claims 32 and 34, and further in view of Canonica (USPN 3,239,956). Claims 42, 45 and 47 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Perali. Claim 32 has been amended. New Claim 51 has been added. No new matter has been added. As set out below, Applicant respectfully submits that the present invention as claimed is patentable over the cited art and urges the Examiner to reconsider the pending rejections.

Claims Rejection - 35 U.S.C. § 102(b); Claims 32, 34, 43, 44, 46 and 48

Examiner Hylton rejected Claims 32, 34, 43, 44, 46 and 48 under 35 U.S.C. § 102(b) as being anticipated by Perali et al (USPN 4,914,762). In making this rejection, Examiner Hylton stated that Perali disclosed all aspects of these claims. More specifically, the Examiner has indicated that water is a liquid cleanser and as such, Perali includes all the elements set out in these claims. As set out below, Applicant traverses this rejection and seeks reconsideration.

It is well settled that prior art under 35 U.S.C. 102(b) must be such that a person of ordinary skill in the field of the invention would consider there to be no difference between the claimed invention and the reference disclosures. In other words, the prior art reference must put the claimed invention in the hand of one skilled in the art. In re Donohue, 766 F.2d 531, 226 USPQ 619, 621 (Fed.Cir. 1985); In re Sasse, 629 F.2d 675, 207 USPQ 107, 111 (CCPA 1980); In re Samour, 571 F.2d 559, 197 USPQ 1, 4 (CCPA 1978). Stated otherwise, even if the claimed invention is disclosed

in a printed publication, such a disclosure will not suffice as prior art if it is not enabling.

All elements of a claimed invention must be "necessarily present" within a prior art patent, either directly or inherently. See, Continental Can Co. USA v. Monsanto Co., 948 F.2d 1264, 1268 (Fed. Cir. 1991). In other words, all elements must be considered in light of the entire disclosure, that is, they must be considered "as taught" by the entire specification. To do otherwise, would allow a non-enabling disclosure to be considered proper prior art, which is improper.

The Perali reference discloses an inflatable cushion to improve the sitting comfort of certain body parts. (Col. 1, lines 5-8) It is constructed of a "front cloth 2," a "rear cloth 3," a "peripheral band 4" and an "inlet-outlet valve 7." (Col. 2, Lines 18-21). The disclosure teaches that the "cloths" can be made from "flexible, washable, airtight and waterproof material, e.g. rubberized canvas," while the "peripheral band" is made from a "thermoplastic sheet material, such as PVC, polyethylene, and the like, or rubber." (Col. 2, Lines 21-26). The "cloths" and the "peripheral band" are sealed together to form an "airtight enclosure 30." (Col. 2, Lines 26-33). Accordingly, the Perali device teaches the combination of two different materials, with one material sandwiched between two sections of the second material to form an enclosure.

The Examiner in making her rejection stated that Perali "teaches a flexible container 1 comprising at least two flexible members 2, 3 forming a chamber therebetween." (Office Action, p. 2) This characterization of the chamber is not accurate and does not account that Perali requires a third member, the "peripheral band 4." Without this member, the Perali device cannot operate and is non-enabling.

Additionally, while the "cloths" in Perali are taught to be "flexible," there is no such teaching for the "peripheral band." In fact, the materials disclosed in connection with this member, PVC, polyethylene, rubber, etc, are not considered to be "flexible" materials. The disclosure teaches that the "peripheral band" is to maintain a mostly trapezoidal configuration. This is assist with keeping the device stationary when placed against the back of a seat or couch. (Col. 2, Lines 50-58; Fig. 5)

The present invention, in contrast, does not create a chamber by sandwiching one type of material with two sections of a second material. The chamber element of Claim 32 has been amended such that it is being created by two flexible members. As such, this limitation is not found in Perali.

The Examiner further stated that the element of liquid cleanser as set forth in Claim 32 is

found in Perali. The Examiner cites to the reference that reads “the cushion 1 can be inflated either by blowing in it a gaseous fluid, such as air, or by filling it with a liquid, e.g. water.” as support. It is, however, respectfully submitted that a liquid cleanser is not considered within the teaching in the context of Perali. In addition to the arguments previously submitted on this issue, Applicant submits that one of the stated purposes of Perali is to use the device as a “water bottle.” (Col. 1, Lines 39-40). Thus, it is acknowledged that Perali teaches the inclusion of water within its enclosure. It is also clear that no other specific liquid is disclosed or taught by Perali.

Thus, in order to find that the term “liquid” as taken in the context of Perali, one skilled in the art must look at the disclosure in its entirety, or other references demonstrating that the claimed subject matter is in the public’s possession. See, In re Donohue, 766 F.2d 531, 226 USPQ 619, 621 (Fed.Cir. 1985) (“The purpose of citing Lincoln and Wagner is, instead, to show that the claimed subject matter, as disclosed in Nomura, was in the public's possession.”) The disclosure is directed toward an inflatable cushion or water-bottle, to be used as a prop for body parts. It is known to inflate cushions with air, water and even temperature controlled gels in the form of heating pad, etc. The Examiner, however, has not provided any sort of reference to show that inflatable cushions or water-bottles have been filled with a liquid cleanser. Accordingly, it is submitted that one skilled in the art, after reviewing Perali would not consider the term “liquid” as out therein to include liquid cleansers.

For the reasons stated above, it is respectfully submitted that all the elements in the claimed invention, as amended, are not found in Perali, and as such are not anticipated by this referenced. Reconsideration of the rejection related thereto are respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claim 50

Examiner Hylton rejected Claim 50 under 35 U.S.C. § 103(a) as being unpatentable over Perali. In making this rejection, Examiner Hylton stated that Perali teaches a liquid can be used to inflate the cushion, and as such it would have been obvious to use liquid soap to fill the cushion. It is respectfully submitted that it would not be obvious to use liquid soap in the manner suggested by the Examiner.

It is clear that liquid soap is not disclosed, taught or suggested to be used in the Perali device, as the disclosure is directed toward an inflatable cushion or water-bottle, to be used as a

prop for body parts. It is known to inflate cushions with air, water and even temperature controlled gels in the form of heating pad, etc. As set out above, the Examiner has not provided any sort of reference to show that inflatable cushions or water-bottles have been filed with a liquid soap. The Examiner is merely inserting her own knowledge or suggestions into this disclosure. Without citing to an actual reference to support this suggestion, such suggestion is not proper and cannot be used to support this rejection.

Further, according to the Examiner, “any liquid” can be used to fill the cushion. Taking this statement to an extreme, the Examiner’s position would hold that it would be obvious to use gasoline, toxic liquids, or other harmful liquids to fill the cushion. However, this position does not take into account the teachings of the Perali invention as a whole. As Perali is directed toward a body cushion or water-bottle, one skilled in the art would consider this device as a therapeutic type of device. To consider that all liquid under the sun are considered to within the teachings of Perali, and be enabling, is not realistic.

Accordingly, it is submitted that one skilled in the art, after reviewing Perali would not consider the term “liquid” as out therein to include liquid cleansers or liquid soap. Accordingly, Perali does not disclose, teach or suggest all the elements of Claim 50. Reconsideration of this rejection is respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claim 48 and 49

Examiner Hylton rejected Claims 48 and 49 under 35 U.S.C. § 103(a) as being unpatentable over Perali et al (USPN 4,914,762) in view of Marrone (USPN 5,007,449). In making this rejection, Examiner Hylton stated that Perali disclosed all aspects of this claim except for a transfigurable slit disposed near the sealed end of the hollow cylinder. However, according to the Examiner, Marrone so discloses and is obvious to combine these references.

As set out above, Perali does not teach all the elements of the Claim 32, thus the combination of these references would not render these claims unpatentable. Accordingly, the combination of Perali and Marrone do not disclose, teach or suggest all the elements of Claims 48 or 49. Reconsideration of this rejection is respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claims 33 and 35

Examiner Hylton rejected Claim 33 under 35 U.S.C. § 103(a) as being unpatentable over

the prior art as applied to Claim 32, and further in view of Gewecke (USPN 3,368,560). In making this rejection, Examiner Hylton stated that Perali disclosed all aspects of this claim except for a transfigurible slit disposed near the sealed end of the hollow cylinder nor teach a hanging means on the flexible container. However, according to the Examiner, Marrone discloses the transfigurible slit and Gewecke discloses the hanging means, and it is obvious to combine these references. As set out below, Applicant traverses this rejection and seeks reconsideration.

As set out above, Perali does not teach the inclusion of liquid cleanser. The inclusion of Marrone and Gewecke do not provide any teaching, suggestion or motivation for the inclusion of liquid cleanser with the container of Perali. Accordingly, it is respectfully submitted that these references do not render Claims 33 and 35 unpatentable. Reconsideration is respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claims 36 -41

Examiner Hylton rejected Claims 36-41 under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to Claims 32 and 34, and further in view of Canonica (USPN 3,239,956).

As set out above, Perali does not disclose the inclusion of liquid cleanser. The inclusion of Marrone, Gewecke or Canonica do not provide any teaching, suggestion or motivation for the inclusion of liquid cleanser with the container of Perali. Accordingly, it is respectfully submitted that these references do not render Claims 36-41 unpatentable.

Moreover, it has been agreed that Canonica is directed to an animated marine display having a transparent tank made from glass, plastic or other suitable material. The Examiner, however, continues reliance thereon by stating that this reference is used to demonstrate the inclusion of an object inside the cushion of Perali for aesthetic purposes. The reliance thereon for this purpose, however, is improper. There needs to exist some motivation, suggestion or teaching to combine the two references. Merely taking one element from a reference and placing it within a second reference with no regard for the teachings thereof, is improper. Due to the lack of teaching, suggestion or motivation in either reference, it is submitted that the combination of the two is improper.

Based on the above, reconsideration of this rejection is respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claims 45 and 47

Examiner Hylton rejected Claims 45 and 47 under 35 U.S.C. § 103(a) as being unpatentable over Perali.

As set out above, Perali teaches an inflatable air cushion having a truncated pyramid structure for use with seats, beds and mattresses. Perali utilizes the truncated pyramid structure to maintain an optimal placement while in use. As set out above, there is no teaching, suggestion or motivation to utilize any other shapes, such as animal or flower shapes. Moreover, this reference only teaches or suggests its structural design to be used as a cushion. This is due to the specific nature of the problem Perali is attempting to address - “to improve the sitting comfort of certain body members.” (Perali, Col. 1, Lines 7-8). To create this device in any other type of structural design would frustrate the purpose of the disclosure. Accordingly, it is respectfully submitted that this reference does not render Claims 45 or 47 unpatentable. Based on the above, reconsideration of this rejection is respectfully requested.

Claims Rejection - 35 U.S.C. § 103(a); Claims 42

Examiner Hylton rejected Claim 42 under 35 U.S.C. § 103(a) as being unpatentable over Perali. In making this rejection, the Examiner took Official Notice that water is the equivalent to liquid emulsifier. The Applicant respectfully disagrees and traverses this rejection. As set out above, a liquid emulsifier and water are different and distinct.

An emulsifier is defined as “a surface-active agent (as a soap) promoting the formation and stabilization of an emulsion.” Merriam-Webster's Medical Dictionary, 2002 Merriam-Webster, Inc. It is well-settled that soap, i.e. an emulsifier, is not water. They have different chemical properties along with different purposes of use.

As used in the Perali disclosure, water can be used to fill an inflatable air cushion having a truncated pyramid structure for use with seats, beds and mattresses. There is no teaching for including any other liquid but water within this structure. As such, Perali does not provide any teaching, suggestion or motivation for the inclusion of liquid emulsifier within the container of Perali. Accordingly, it is respectfully submitted that this reference does not render Claim 42 unpatentable.

Commercial Success

Applicant submits that as evidence of the nonobviousness of the claimed invention, it has obtained sufficient commercial success to overcome the Examiner's obviousness conclusion. The success of the Applicant's invention is directed related to the features claimed in the pending claims, to-wit: a flexible chamber having liquid soap or other cleaner therein. This success is evidenced by the size of the market share, growth of the market share since the inventive product was introduced into the public and the number of infringers since the introduction of the inventive product. Accordingly, the commercial success of the inventive product is evidence of the non-obviousness of the claims set for in the present application. Thus, reconsideration of the outstanding rejections is respectfully requested.

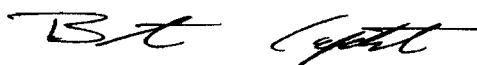
New Claim 51

New Claim 51 has been added. No new matter has been added. New Claim 51 includes the limitation that the liquid cleanser is taken from the group of liquid soap, bubble bath, shampoo and conditioner. As this claim depends from Claim 32, for the reasons set forth above, it is respectfully submitted it is in condition for allowance.

Conclusion

For the reasons set forth above, it is respectfully submitted the above claims, as amended, are not rendered unpatentable over the cited prior art and are in a condition for allowance. Reconsideration of the rejections is respectfully requested.

Respectfully submitted,



Brent A. Capehart
Reg. No. 39,620

BAC/rm
Filed: December 5, 2006
LARIVIERE, GRUBMAN & PAYNE, LLP
19 Upper Ragsdale Drive, Suite 200
Monterey, CA 93940
831/ 649 8800
Fax 831/ 649 8835